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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,180

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Kia Silverbrook

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EXAMINER

GARCIA JR, RENE

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,180	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> RENE GARCIA JR	<b>Art Unit</b> 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,8-18,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/03/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1, 2, 3, 6, 7 and 19-25 in the reply filed on 21 December 2007 is acknowledged.
2. Claims 4, 5, 8-18, 26 and 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subcombination, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 21 December 2007.

### *Specification*

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because use of "comprising", legal phraseology. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities: listing of filing docket numbers for co-pending applications, should list US Application number or appropriate US Patents. Appropriate correction is required.

### *Claim Objections*

6. Claim 3 is objected to because of the following informalities: line 4, "I" does not belong at the end of sentence. Appropriate correction is required.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Instant application is rejected based on nonstatutory double patenting based on US Patent 7,111,935 and copending applications: 10/760, 213; 10/760,219; 10/760,252; 11/503,083; 10/760, 237; 10/760,220. The basis for these rejections is outlined below.

9. Claims 1, 2 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 7,111,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing functions/elements of claims 1, 2 and 3 are within the above mentioned patent (US 7,111,935) which pertains to a print media and printing fluid cartridge for a digital photofinishing system. While US Patent 7,111,935 claims the print media and printing fluid cartridge and instant application is directed to a digital

photofinishing apparatus, the patent incorporates the same features of the digital photofinishing system relevant to the instant application.

Claimed in US Patent 7,111,935 is a print media and printing fluid cartridge for a digital photofinishing system. It includes: digital processor, printer, receiving of drive signals, cartridge mounted removably in juxtaposition to printer, cartridge is a roll of print media, cartridge incorporating drive means for coupling with a print media drive mechanism, at least one removable printing fluid first cartridge [claim 1]; digital processor arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, the printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media [claim 2].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3].

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10. Claims 1, 2 and 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 3 of copending Application No. 10/760,213. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2 and 3 are within the above mentioned application (10/760,213) which pertains to a cartridge for a digital photofinishing system. While copending application 10/760,213 claims a cartridge and instant application is directed to a digital photofinishing apparatus, the copending application incorporates the same features of the digital photofinishing system relevant to the instant application.

Claimed in copending application 10/760,213 is a cartridge for a digital photofinishing system including: digital processor, printer arranged to receive drive signals from the digital processor, cartridge mounted removably in juxtaposition to the printer, source of printing fluid to be delivered on demand to the printer, means for coupling with a print media feed drive mechanism [claim 1]; digital processor receiving digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media [claim 2]; replaceable roll of print media [claim 3].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic

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image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1, 2 and 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/760,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2 and 3 are within the above mentioned application (10/760,219) which pertains to a cartridge for a digital photofinishing system. While copending application 10/760,219 claims a cartridge and instant application is directed to a digital photofinishing apparatus, the copending application incorporates the same features of the digital photofinishing system relevant to the instant application.

Claimed in copending application 10/760,219 is a cartridge for a digital photofinishing system including: digital processor, printer arranged to receive drive signals from the digital processor, cartridge mounted removably in juxtaposition to the printer, replaceable roll of print media, replaceable source of printing fluid, both of which are arranged to be delivered on demand to the printer [claim 1]; digital processor is arranged to receive digitised data that is

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representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media [claim 2].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1, 2, 3, 6 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 6 and 7 of copending Application No. 10/760,252. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2, 3, 6 and 7 are within the above mentioned application (10/760,252) which pertains to a digital photofinishing system.



Claimed in copending application 10/760,252 is a digital photofinishing system including:

digital processor, printer, means for feeding print media to the printer from a roll of the print media, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed directly to the printer from the roll, printer incorporating at least one print head assembly that is arranged to provide for printing of the print media with a feed rate up to 2 metres per second [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge is arranged to be mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3]; at least one printing fluid is provided for the printer by way of at least one replaceable printing fluid cartridge [claim 4]; printing fluid cartridge is arranged to be mounted removably in juxtaposition to the printer [claim 5]; primary cartridge that is arranged to be mounted removably in juxtaposition to the printer, the primary cartridge housing the roll of print media to be fed to the printer and incorporating means for coupling with a print media feed drive mechanism, and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer [claim 6]; roll of print media is removably mounted to a tubular core of the primary cartridge and wherein the at least one secondary cartridge is removably located within the tubular core [claim 7].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3]; primary cartridge that is arranged to be mounted removably in juxtaposition to the printer, the primary cartridge housing the roll of print media to be fed to the printer and incorporating means for coupling with a print media feed drive mechanism, and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer [claim 6]; roll of print media is removably mounted to a tubular core of the primary cartridge and wherein the at least one secondary cartridge is removably located within the tubular core [claim 7].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit printing of the print media with a feed rate up to 2 meters per second [claim 1 of 10/760,252]. It has been held that discovering an optimum value of a result effective variable involve only routine skill in the art. **In re Boesch, 617 F.2d 272, 205 USPQ 215 (C.C.P.A. 1980).** It has been held that omission of an element and its function would have been obvious if this feature was not desired. **In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA**

**1965). Elimination Of A Step Or An Element And Its Function.** It is further evidence that the feed rate is not required for instant application functionality based on claim 26 of instant application [now withdrawn] providing same functionality outside the scope of independent claim 1 of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1, 2, 3, 19, 20, 21, 22, 23, 24 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 6 and 7 of copending Application No. 11/503,083. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2, 3, 19, 20, 21, 22, 23, 24 and 25 are within the above mentioned application (11/503,083) which pertains to print media and printing fluid cartridge of a digital photofinishing system. While copending application 11/503,083 claims a print media and printing fluid cartridge and instant application is directed to a digital photofinishing apparatus, the copending application incorporates the same features of the digital photofinishing system relevant to the instant application.

Claimed in copending application 11/503,083 is a print media and printing fluid cartridge removably mounted to a support structure of a digital photofinishing system including: print media and printing fluid cartridge removably mounted to a support structure of a digital photofinishing system in juxtaposition with a printer mounted to the support structure, digital processor, print media drive mechanism for the printer, roll of print media, print media delivery arrangement arranged to couple with the print media drive mechanism so as to feed the print

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media from the roll to the printer on demand, at least one removable printing fluid first cartridge for feeding printing fluid to the printer on demand [claim 1]; support structure includes a compartment and the cartridge is removably located in the compartment [claim 2]; roll of the print media is arranged to engage with the print media drive mechanism which is mounted to the compartment [claim 3]; wall having a door which is arranged to be opened to enable the print media delivery arrangement to couple with print media drive mechanism [claim 4]; print media delivery arrangement includes a drive roller and a pinch roller [claim 5]; print drive mechanism has a pivotal carrier, first drive motor arranged to impart pivotal drive to the carrier, primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the cartridge is open, second drive motor arranged to impart rotary drive to the primary roller, third drive motor mounted to the support structure which engages the drive roller of the print media delivery arrangement [claim 6]; digital processor is arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a drive signal that is representative of the photographic image for the printer, the printer being arranged to process the drive signal and effect page-width printing of the photographic image on the print media fed from the roll of print media using the printing fluid fed from the printing fluid first cartridge [claim 7].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive

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signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3]; processor and the printer are mounted to a support structure and wherein a primary cartridge containing a replaceable said roll of the print media is removably mounted to the support structure [claim 19]; support structure includes a compartment and the primary cartridge is removably located in the compartment [claim 20]; print media feed means are located in the primary cartridge and drive means are provided on the support structure and are arranged to couple with the feed means to effect feeding of the print media through the printer when the primary cartridge is mounted to the support structure [claim 21]; paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media [claim 22]; door is provided in a wall portion of the primary cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media [claim 23]; paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller [claim 24]; print media feed means include a drive roller and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure [claim 25].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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14. Claims 1, 2, 3, 6, 7, 19, 20, 21, 22, 23, 24 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 5, 6, 7, 19, 20, 21, 22, 23, 24 and 25 of copending Application No. 10/760,237. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2, 3, 6, 7, 19, 20, 21, 22, 23, 24 and 25 are within the above mentioned application (10/760,237) which pertains to a photofinishing system.

Claimed in copending application 10/760,237 is a photofinishing system including: processor, printer, means for feeding print media to the printer from a roll of the print media, drier means coupled to the printer, processor being arranged to generate a drive signal that is representative of a photographic image, the printer being coupled to the processor and being arranged to process the drive signal and effect printing of the photographic image on the print media, and the drier means being arranged to receive printed media directly from the printer, to transport the printed media from the printer and, in use, to effect drying of the printed media during transportation of the media [claim 1]; processor is a digital processor which is arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, and the printer is arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed directly to the printer from the roll [claim 2]; roll of print media is provided by way of a replaceable cartridge [claim 3]; cartridge is arranged to be mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 4]; at least one printing fluid is

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provided for the printer by way of at least one replaceable printing fluid cartridge [claim 5]; primary cartridge that is arranged to be mounted removably in juxtaposition to the printer, the primary cartridge housing the roll of print media to be fed to the printer, and incorporating means for coupling with a print media feed drive mechanism, and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer [claim 6]; roll of print media is removably mounted to a tubular core of the primary cartridge and wherein the at least one secondary cartridge is removably located within the tubular core [claim 7]; processor and the printer are mounted to a support structure and wherein a cartridge containing a replaceable said roll of the print media is removably mounted to the support structure [claim 19]; support structure includes a compartment and the cartridge is removably located in the compartment [claim 20]; print media feed means are located in the cartridge and drive means are provided on the support structure and are arranged to couple with the feed means to effect feeding of the print media through the printer when the cartridge is mounted to the support structure [claim 21]; paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media [claim 22]; door is provided in a wall portion of the cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media [claim 23]; paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller [claim 24]; print media feed means include a drive roller

and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure [claim 25].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3]; primary cartridge that is arranged to be mounted removably in juxtaposition to the printer, the primary cartridge housing the roll of print media to be fed to the printer and incorporating means for coupling with a print media feed drive mechanism, and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer [claim 6]; roll of print media is removably mounted to a tubular core of the primary cartridge and wherein the at least one secondary cartridge is removably located within the tubular core [claim 7]; processor and the printer are mounted to a support structure and wherein a primary cartridge containing a replaceable said roll of the print media is removably mounted to the support structure [claim 19]; support structure includes a compartment and the primary cartridge is removably located in the compartment [claim 20]; print media feed means are located in the primary cartridge and drive means are provided on the



support structure and are arranged to couple with the feed means to effect feeding of the print media through the printer when the primary cartridge is mounted to the support structure [claim 21]; paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media [claim 22]; door is provided in a wall portion of the primary cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media [claim 23]; paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller [claim 24]; print media feed means include a drive roller and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure [claim 25].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit drier means coupled to the printer [claim 1 of 10/760,237]. It has been held that omission of an element and its function would have been obvious if this feature was not desired. **In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Elimination Of A Step Or An Element And Its Function.** It is further evidence that the drier means is not required for instant application functionality based on claim 15 of instant application [now withdrawn] providing same functionality outside the scope of independent claim 1 of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1, 2, 3, 19, 20, 22, 23, 24 and 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 18, 19, 20, 21, 22, 23, 24 and 25 of copending Application No. 10/760,220. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art that the existing elements/functions of claims 1, 2, 3, 19, 20, 22, 23, 24 and 25 are within the above mentioned application (10/760,220) which pertains to a photofinishing system.

Claimed in copending application is a photofinishing system including: support structure, a processor and a printer mounted to the support structure, a cartridge containing a roll of print media arranged in use to be mounted removably to the support structure, print media feed means located in the cartridge, and drive means mounted to the support structure and arranged to couple with the print media feed means, when the cartridge is mounted to the support structure, and to effect feeding of the print media through the printer, the processor being arranged to generate a printer drive signal that is representative of a photographic image, and the printer being coupled to the processor and arranged to process the drive signal and effect printing of the photographic image on the print media as the print media is fed through the printer from the cartridge [claim 1]; processor is a digital processor which is arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, and the printer is arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed directly to the printer from the roll [claim 2]; cartridge is arranged to be mounted removably in juxtaposition to the printer [claim 3]; processor and the printer are

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mounted to a support structure and wherein the cartridge containing a replaceable said roll of the print media is removably mounted to the support structure [claim 18]; support structure includes a compartment and the cartridge is removably located in the compartment [claim 19]; paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media [claim 20]; door is provided in a wall portion of the cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media [claim 21]; paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller [claim 22]; print media feed means include a drive roller and a pinch roller, and wherein the drive means includes a third drive motor which is mounted to the support structure [claim 23].

Claimed in instant application 10/760,180 is a digital photofinishing system including: digital processor, printer, means for feeding print media to the printer, digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image, printer being coupled to the digital processor and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer from the roll [claim 1]; roll of print media is provided by way of a replaceable cartridge [claim 2]; cartridge mounted removably in juxtaposition to the printer and wherein the cartridge incorporates means for coupling with a print media feed drive mechanism [claim 3]; processor and the printer are mounted to a support structure and wherein a primary

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cartridge containing a replaceable said roll of the print media is removably mounted to the support structure [claim 19]; support structure includes a compartment and the primary cartridge is removably located in the compartment [claim 20]; paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media [claim 22]; door is provided in a wall portion of the primary cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media [claim 23]; paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller [claim 24]; print media feed means include a drive roller and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure [claim 25].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2, 3, 6, 7 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook (US 2002/0183088).

**Silverbrook discloses the following claimed limitations:**

\*regarding claim 1, digital photofinishing system/**printer phone, 1/** (fig. 1; ¶0034, 0001) comprising:

\*digital processor/**ASICS/** (fig. 7; ¶0039, 0047), a printer/**printer unit, 12/** (fig. 2, 3; ¶0035) and means for feeding print media/**feed means, 17/** (fig. 3, 4; ¶0037) to the printer/**12/** from a roll of the print media/**cartridge, 51/** (fig. 15; ¶0044); the digital processor being arranged to receive digitised data that is representative of a photographic image and to process the data in a manner to generate a printer drive signal that is representative of the photographic image (¶0039, 0036), and the printer/**12/** being coupled to the digital processor/**ASIC/** and being arranged to process the drive signal and effect page-width printing of the photographic image on the print media as it is fed to and through the printer/**12/** from the roll/**51/** (¶0043, 0042)

\*regarding claim 2, roll of print media/**51/** is provided by way of a replaceable cartridge (¶0048)

\*regarding claim 3, cartridge/**51/** is arranged to be mounted removably in juxtaposition to the printer/**12/** and wherein the cartridge/**51/** incorporates means for coupling with a print media feed drive mechanism (fig. 15; ¶0048, 0046, 0037)

\*regarding claim 6, primary cartridge/**51/** that is arranged to be mounted removably in juxtaposition to the printer/**12/**, the primary cartridge housing the roll of print media/**12/** to be fed to the printer/**12/** and incorporating means for coupling with a print media feed drive mechanism,

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and at least one refillable secondary cartridge carried by the primary cartridge, the secondary cartridge containing printing ink to be delivered to the printer (fig. 15; ¶0044, 0048)

\*regarding claim 7, roll of print media is removably mounted to a tubular core of the primary cartridge and wherein the at least one secondary cartridge is removably located within the tubular core (fig. 15; ¶0046, 0048)

\*regarding claim 19, processor and the printer/12/ are mounted to a support structure/**phone casing, 50/** and wherein a primary cartridge/51/ containing a replaceable said roll of the print media is removable mounted to the support structure (¶0044; 0048)

\*regarding claim 20, support structure includes a compartment and the primary cartridge is removably located in the compartment (fig. 15; ¶0046)

### ***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (US 2002/0183088) [Silverbrook '088] in view of Silverbrook (US 6,362,868) [Silverbrook '868] and Silverbrook et al. (US 2002/0093569) [Silverbrook '569].

**Silverbrook '088 discloses the following:**

Silverbrook discloses that the cartridge/51/ is substantially the same as US Application 09/113,053, now US Patent 6,362,868. Therefore it is obvious to incorporate features of Silverbrook '868 into Silverbrook '088 to achieve the cartridge system, ¶0042.

It is also obvious to a person having ordinary skill in the art to recognize that Silverbrook '868 cartridge is similar to that of Silverbrook '569, and that Silverbrook '569 utilizes a cartridge from co-pending US Application 09/607,993 [US Patent 6,238,044] and 09/607,251 [US Patent 6,425,661] (¶0036). Therefore the references combined are related art and thus is obvious to utilize features to achieve claimed invention of instant application under 35 U.S.C. 103(a). The purpose of the combination would be to incorporate a replaceable print media and print ink into a printer phone to simplify the usage to end user.

**Silverbrook '088 does not disclose the following claimed limitations:**

\*regarding claim 21, print media feed means are located in the primary cartridge and drive means are provided on the support structure and are arranged to couple with the feed means to effect feeding of the print media through the printer when the primary cartridge is mounted to the support structure

\*regarding claim 22, paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media

\*regarding claim 23, door is provided in a wall portion of the primary cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media

\*regarding claim 24, paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller

\*regarding claim 25, print media feed means include a drive roller and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure

**Silverbrook '868 teaches the following:**

\*regarding claim 21, print media feed means are located in the primary cartridge (fig. 227-231; col. 262, line 43 – col. 263, line 9)

\*regarding claim 22, paper feed drive mechanism is mounted to the compartment and is arranged to engage a said roll of the print media (fig. 227-231; col. 262, line 43 – col. 263, line 9)

\*regarding claim 25, print media feed means include a drive roller and a pinch roller, and wherein the drive means comprises a third drive motor which is mounted to the support structure (col. 262, line 43 – col. 263, line 9; fig. 227-231)



**Silverbrook '569 teaches the following:**

\*regarding claim 21, drive means are provided on the support structure and are arranged to couple with the feed means to effect feeding of the print media through the printer when the primary cartridge is mounted to the support structure (fig. 1-5; ¶0040)

\*regarding claim 23, door/**engageable portion, 540**) is provided in a wall portion of the primary cartridge and wherein the door is arranged to be opened to enable the paper feed drive mechanism to engage the roll of print media (fig. 2; ¶0040)

\*regarding claim 24, paper feed drive mechanism comprises a pivotal carrier, a first drive motor arranged to impart pivotal drive to the carrier, a primary drive roller mounted to the carrier and arranged to engage the roll of print media when the door in the primary cartridge is open, and a second drive motor arranged to impart rotary drive to the primary roller (¶0040)

**Communication with the USPTO**

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RENE GARCIA JR whose telephone number is (571)272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. G./  
Examiner, Art Unit 2853

/Stephen Meier/  
Supervisory Patent Examiner, Art Unit 2853